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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,483	02/01/2000	Ken R. Powell	104.005-003	4924

7590 02/20/2003

Law Office of Jerome D. Jackson
211 N. Union Street
Suite 100
Alexandria, VA 22314

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/495,483

Applicant(s)

POWELL, KEN R.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

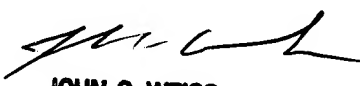
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-93 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-93 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 03 April 2000 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Specification

1) The amendment filed April 3, 2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

the independent claims covered systems or methods in which customers receive coupons onto non-card portable computing devices (housing) when the original claimed subject matter is cards (190); the housing contains a processing unit that executes a program stored in a random access memory; and the telecommunications signal includes a signal identifying a consumer.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3) Claims 14-15, 21-22, 28-29, 35-36, 42-43, 49-50, 56-57, 62-63, 69-70, 75-76, 82-83 and 89-90 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The above cited claims contain the housing including a processing unit that executes a program stored in a random access memory and the telecommunications signal including a signal identifying a consumer, which were not supported in the original disclosure so that it reasonably deems that the inventor(s), at the time the original application was filed, didn't have possession of the claimed invention.

Double Patenting

4) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5) Claims 12, 13, 16, 17, 18, 19, 20, 23, 24, 25, 26, 27, 30, 31, 32, 33, 34, 37, 38, 39, 40, 41, 44, 45, 46, 47, 48, 51, 52, 53, 54, 55, 58, 59, 60, 61, 64, 65, 66, 67, 68, 71, 72, 73, 74, 77, 78, 79, 80, 81, 84, 85, 86, 87, 88, 91, 92, and 93 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over, respectively, claims 2, 2, 4, 5, 6, 3, 7, 8, 9, 10, 11, 11, 13, 14, 15, 12, 16, 17, 18, 19, 20, 20, 21, 22, 23, 24, 24, 25, 26, 27, 28, 28, 29, 30, 31, 32, 33, 34, 35, 36, 36, 37, 38, 39, 40, 41, 42, 43, 44, 44, 45, 46, 47, 48, 48, 49, 50, and 51 of U.S. Patent No.

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6,067,526. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,067,526 claims:

In a system including a plurality of portable cards, a plurality of homes, a store and a routing system, the routing system including a plurality of wide area communication links, a retail system comprising:

a first computer; and

a second computer, wherein the first computer includes circuitry for sending first signals to the routing system, each first signal including a signal corresponding to a product, and an inter-network address corresponding the second computer, to cause the routing system to generate a plurality of network address (or to generate a plurality of routing signals), each of the plurality of network address corresponding to a respective computer in a respective computer network (each of the plurality of routing signals corresponding to a respective portion of a signal path between the first and second computers), and wherein the second computer includes circuitry for receiving first signals, and wherein the system further includes:

a plurality of first processors, each located in one of the plurality of homes, responsive to a first signal received by the second computer, for sending a card signal to a portable card in the plurality of cards, the card signal corresponding to the product; and

a second processor, in the store, for receiving the card signal from a portable card in the plurality of cards.

'526 Patent further claims method comprising:

sending first signals from a first computer to the routing system, each first signal including a signal corresponding to a product, and an inter-network address corresponding to a second computer, to cause the routing system to generate a plurality of network address (or to generate a plurality of routing signals), each of the plurality of network address corresponding to a respective computer in a respective computer network;

receiving first signals, and

the step, performed in one of the homes, of

sending, responsive to a first signal received in the previous step, a card signal to a portable card in the plurality of cards, the card signal corresponding to the product, and

the step of

subsequently, moving the portable cards to the store, and
the step, performed in the store, of

receiving the card signal from the portable card.

Although '526 patent does not expressly claim the invention including "housing" and "memory signal", there is deemed to be no significant difference between the housing and card and, respectively, between card signal and memory signal, and both the instant application and '526 patent claim the same subject matter in each corresponding claim.

Conclusion

6) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 3,622,995 is cited to show data processing systems for automatic, on-line checking of numbered reservations and/or the control of credit card purchases, without referencing any data on the ticket or credit card itself.

US 4,982,346 is cited to show a computer system automating advertising and promotional campaign. The system includes a magnetic stripe card reader, barcode reader, monitor printer, keyboard, and touch screen input device. Customers are attracted to the system by promotional sweepstakes, thereby enhancing the effectiveness of the advertising and surveys.

US 6,336,098 is cited to show a method and system for electronic distribution and redemption of coupons on a computer network. The method includes the step of: providing an electronic coupon in the form of a machine readable computer file; permitting a user of a client machine to receive the computer file via the computer network; storing the computer file on the client machine and authorizing a benefit.

US 6,450,407 is cited to show a method and system for providing advertisement information, including advertising as well as sales promotions, on chip cards that additionally involves an electronic money rebate to the consumer, and for the distribution, accounting, and recovery of the associated electronic money rebates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-

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7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

A handwritten signature in black ink, appearing to read 'Richard Woo', with a stylized flourish at the end.

Richard Woo
Patent Examiner
GAU 3629
February 10, 2003